

REMARKS

This is intended as a full and complete response to the Final Office Action dated February 28, 2005, having a shortened statutory period for response set to expire on May 28, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 3-14, 16-19, and 23-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Mullick et al.* (U.S. Publication No. 2003/0167000 A1). In response, Applicants respectfully traverse the rejection and have canceled claims 7-8, 10-14 and 19 without prejudice.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Further, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 1 includes the limitation of a laparoscopic surgical tool with a port that a micro-robot is adapted to fit through. However, *Mullick et al.* does not teach a system with a laparoscopic surgical tool. Rather, *Mullick et al.* discloses a capsule for imaging and therapy of a gastrointestinal tract by ingestion of the capsule such that non-invasive, non-interventional procedures can be performed on patients using the capsule. Therefore, *Mullick et al.* cannot anticipate claim 1 and claims 3-6, 9, 16-18 and 23-25 dependent thereon since the reference fails to teach each and every limitation. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Applicants further traverse the rejection of dependent claims 23 and 24. These claims recite that an imaging device is movable relative to a body of a micro-robot to adjust a position of the imaging device. The Examiner has not indicated where in

Mullick et al. that the claimed features are taught. Further, an imaging device of the capsule disclosed in *Mullick et al.* is fixed within the capsule without any indication of the imaging device being movable relative to the capsule's body to adjust a position of the imaging device. Therefore, the failure of *Mullick et al.* to teach each and every limitation in claims 23 and 24 further prevents *Mullick et al.* from anticipating these claims. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 26 includes the limitation of a mobilization assembly for actively moving a body of a micro-robot during surgery along a surface within an open space inside an animal body. Insufflating a patient during surgery creates the open space within the patient where the mobilization assembly moves the micro-robot. The capsules disclosed in *Mullick et al.* lack mobility arrangements that enable active movement along a surface within an open space where gravity creates a normal force for traction. Rather, the capsules disclosed in *Mullick et al.* require surrounding surfaces (i.e., a ceiling and walls) to push on and therefore do not operate to provide movement on a surface within an open space. Specifically, all the mobility arrangements taught in *Mullick et al.* can only operate inside the gastrointestinal tract where these surrounding surfaces are available and utilized by the mobility arrangements to provide movement to the capsule. Therefore, *Mullick et al.* fails to teach each and every limitation contained in claim 26 and new claims dependent thereon. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 27 includes the limitations of performing an incision in an animal body, implanting a micro-robot through the incision into an open space inside the animal body and actively moving the micro-robot along a surface inside the animal body within the open space by operation of a mobilization assembly. In contrast, *Mullick et al.* discloses procedures that are non-invasive, non-interventional since a capsule is simply ingested. Further, moving the capsules disclosed in *Mullick et al.* does not occur within an open space but rather in a gastrointestinal tract where there are surrounding surfaces (i.e., a ceiling and walls) to push on. Therefore, *Mullick et al.* fails to teach each and every limitation contained in claims 27 and 28 and new claims dependent on claim 27.

Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Chance E. Hardie
Registration No. 55,247
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants